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EXAMINER

ABEL JALIL, NEVEEN

ART UNIT PAPER NUMBER

2175

DATE MAILED: 10/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/788,491

Applicant(s)

NAKANO ET AL.

Examiner

Neveen Abel-Jalil

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Amendments filed on 6/27/2003 & 8/1/2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The amendments filed on June 27, 2003 and August 1, 2003 has been received and entered. Claims 19-22 have been added. Therefore, claims 1-22 are pending.
2. Newly amended title has been received and acknowledged.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 8, 11, 13, 14-18, 21-22 are rejected under 35 U.S.C. 102(e) as being anticipated by De La Hueraga et al. (U.S. Patent No. 5,895,461).

As to claims 1, and 13, De La Hueraga et al. discloses an information searching apparatus for searching location information that represents the location of content information which is concerned with a keyword transmitted from a user's terminal apparatus (See column 10, lines 1-67, wherein "information searching apparatus" reads on "Internet browser", and wherein "searching location information" reads on "data record.... database storage location", and wherein "content information" reads on "admission report", and wherein "user's terminal" reads on "consumer's computer"), comprising:

a database for storing location information which is about prescribed content information that exists on the network and is unpublished on the network (See column 12, lines 14-61, also see column 9, lines 55-67, and column 10, lines 1-20); and

a searching unit searching for the location information by referring to the database only when searching got the location based on a keyword (See column 4, lines 1-55, also see column 10, lines 12-20, wherein “searching unit” reads on “browser”) that is transmitted from a user's terminal apparatus (See column, wherein “input field” reads on “graphical user interface”, and wherein “user’s terminal” reads on “client computer”) browsing specific web page containing a search keyword input field to which the keyword is input and is input in the search keyword field (See column 10, lines 20-67).

As to claims 8, and 14, De La Huerga et al. discloses an information server (See column 13, lines 22-38), connected to a network, for transmitting stored information to the network (See column 13, claim 1 language, wherein “stored information” reads on “database”), comprising:

a search keyword input page transmitting unit transmitting a web page to a user's terminal apparatus (See column 10, lines 1-67, wherein “transmitting unit transmitting a web page” reads on “URL”), the web page containing a search keyword input field in which a keyword is input (See), the keyword causing an information searching apparatus to search for location information representing the location of content information on the network (See column 13, claim 1, language) where information exists containing a keyword transmitted from the user’s terminal apparatus, based on the keyword (See column 6, lines 33-61); and

a location unpublished information transmitting unit transmitting unpublished location information, the location of the network of which is unpublished the location information representing which the information searching apparatus can searching for only by inputting a keyword to search the keyword input field of the web page browsed on the user's terminal apparatus, to the user's apparatus in response to a request issued by the user's terminal apparatus (See column 9, lines 18-67, and column 10, lines 1-67).

As to claims 11, and 15, De La Hueraga et al. discloses a user's terminal apparatus, connected to a network (See column 6, lines 1-30), comprising:

a web page browsing unit browsing a web page containing a search keyword input field in which a keyword is input, the keyword causing an information searching apparatus to search location information representing the location of content information (See column 10, lines 52-67) the location on the network where information exists containing the keyword transmitted from the user's terminal apparatus and on which the location information of the content information, the location on the network is unpublished, can be searched for, only based on a keyword input to the search input field (See column 9, lines 18-67, and column 10, lines 1-67); and

a search keyword transmitting unit transmitting the keyword that has been input in the search keyword input field to the information searching apparatus (See column 14, claim 12 language, wherein "transmitting unit " reads on "connected by a telecommunications connection", also see column 10, lines 52-67, wherein "information searching apparatus" reads on "Internet browser").

As to claims 16, 17, and 18, De La Huerga et al. discloses a computer readable storing medium for storing an information searching program (See column 2, lines 17-51), a computer data signal embodied in a carrier wave and representing an information searching program that causes a computer to perform a control operation for searching location information that represents the location of content information on a network where exists information containing a keyword transmitted from a user's terminal apparatus (See column 2, lines 17-67, prior art, also see column 3, lines 26-42), the information searching program comprising:

obtaining a keyword that is transmitted from the user's terminal apparatus browsing a specific web page containing a search keyword input field to which the keyword is input (See column 2, lines 17-67, prior art); and

making a search by referring to a database storing location information which is about prescribed content information that exists on the network and is unpublished on the network (See column 9, lines 18-50), only when searching for the location information, based on the keyword input to the search keyword input field (See column 9, lines 55-67, and see column 10, lines 1-67).

As to claim 21, De La Huerga et al. discloses a search method, comprising:

receiving a search request including keyword and a source identifier;

determining whether the source identifier corresponds to a search page for searching unpublished network accessible pages (See page 4, lines 15-55, wherein "source identifier" reads on "keyword");

searching a published page index using the keyword when the source identifier does not correspond to the search page for searching unpublished network accessible pages (See page 11, lines 5-51, wherein “does not correspond” reads on “error”); and

searching an unpublished page index and the published page index when the source identifier corresponds to the search page for searching unpublished network accessible pages (See column 9, lines 55-67, and see column 10, lines 1-67).

As to claim 22, De La Hueraga et al. discloses a search method, comprising:

receiving a search request including keyword and a source identifier; determining whether the source identifier corresponds to a search page for searching unpublished network accessible pages; and searching an unpublished page index and the published page index when the source identifier corresponds to the search page for searching unpublished network accessible pages (See column 9, lines 55-67, and see column 10, lines 1-67, wherein “source identifier” reads on “URL”).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 2-7, 9-10, 12, 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over De La Huerga et al. (U.S. Patent No. 5,895,461) further in view of Eggleston et al. (U.S. Patent No. 6,061,660)

As to claim 2, De La Huerga et al. discloses wherein the content information whose location information is unpublished (See De La Huerga et al. column 9, lines 55-67, and column 10, lines 1-20)

De La Huerga et al. does not teach is award entry information.

Eggleston et al. teaches is award entry information. (See Eggleston et al. column 33, lines 56-65, also see column 35, lines 60-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified De La Huerga et al. to include is award entry information.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified De La Huerga et al. by the teaching of Eggleston et al. to include is award entry information because a database can store any user customizable information/records fitting to the user's preference regardless of its type.

As to claim 3, De La Huerga et al. as modified discloses wherein the web page contains a keyword with which the location information of the award entry information is obtained as a search result of said searching unit (See Eggleston et al. column 16, lines 32-67, and Eggleston et al. column 17, lines 1-8, wherein "location information" reads on "link to a page containing

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information”, and wherein “award entry” reads on “incentive program”, also see De La Huerga et al. column 6, lines 20-44).

As to claim 4, De La Huerga et al. as modified discloses wherein when a plurality of records of the location information are obtained as the search result corresponding to the keyword (See Eggleston et al. column 15, lines 27-56, wherein “location information” reads on “URL for the award site”), said searching unit outputs rankings corresponding to the correlation of content information represented by the location information and the keyword (See Eggleston et al. column 12, lines 49-67, wherein “searching unit” reads on “customer website...permits the customer to search”), and

wherein the award entry information is highly correlated with the keyword contained in the web page (See Eggleston et al. column 15, lines 50-56, wherein “award entry information” reads on “obtain particular prize”, and wherein “highly correlated “ reads on “linked”, and wherein “web page” reads on “consumer site and the sponsor side”, also see Eggleston et al. column 12, lines 38-48, also see De La Huerga et al. column 6, lines 12-30).

As to claim 5, De La Huerga et al. as modified discloses wherein the award entry information contains an input field in which the keyword is input (See Eggleston et al. column 12, lines 49-67, wherein “award entry” reads on “incentive program”) and is described in HTML (HyperText Markup Language) (See Eggleston et al. column 11, lines 8-15, also see De La Huerga et al. column 2, lines 52-67), and

wherein the award entry information is highly correlated with the keyword contained in the web page in such a manner that the keyword (See Eggleston et al. column 12, lines 38-48, wherein “correlated” reads on “linked”, also see De La Huerga et al. column 4, lines 15-44) is contained in a portion defined in a META tag described in HTML (See Eggleston et al. column 14, lines 56-67, and column 15, lines 1-8).

As to claim 6, De La Huerga et al. as modified discloses wherein the web page contains an award entry keyword, wherein the award entry information is a web page containing an award keyword input field in which the entry keyword is input (See Eggleston et al. column 15, lines 50-56, wherein “award entry information” reads on “obtain particular prize”, and wherein “keyword input field” reads on “search site by topic or keyword”, also Eggleston et al. see column 12, lines 38-48), and

wherein the apparatus further comprises determining unit determining whether or not the award entry has been performed by inputting the entry keyword in the entry keyword input field (See Eggleston et al. column 14, lines 6-49, wherein “determining unit” reads on “a sponsor... is asked to select among various types... application program of the host program”, and wherein “award entry” reads on “incentive program”, and wherein “inputting the entry keyword” reads on “characteristics selected by the sponsor”).

As to claim 7, De La Huerga et al. as modified discloses further comprising a search entry summing unit summing the number of entries (See Eggleston et al. column 31, lines 25-50, wherein “summing unit” reads on “categorized by a number of different

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characteristics”) for each keyword that have been input in the search keyword input field and searched by said searching unit (See Eggleston et al. column 34, lines 20-53, wherein “search keyword input field” reads on “define the characteristics of a particular incentive program”, also see Eggleston et al. column 27, lines 29-59).

As to claim 9, De La Huerga et al. discloses wherein the content information whose location is unpublished (See De La Huerga et al. column 9, lines 55-67, and see De La Huerga et al. column 10, lines 1-20, wherein “location” reads on “URL”),

wherein an entry keyword appears on the web page (See column 14, claim 12 language), wherein the content information transmitted from said location unpublished information (See De La Huerga et al. column 9, lines 55-67, and see De La Huerga et al. column 10, lines 1-20) transmitting unit contains a web page containing an entry keyword input field in which the entry keyword is input (See).

De La Huerga et al. does not teach is award entry information;

wherein the information server further comprises an accepting unit determining whether or not an award entry keyword that has been input in the entry keyword input field is the same as a search keyword that has appeared on a web page containing a search keyword input field an accepting an award entry when they are the same when the award entry is transmitted from the user's terminal apparatus through the network.

Eggleston et al. teaches is award entry information. (See Eggleston et al. column 33, lines 56-65, also see column 35, lines 60-67);

wherein the information server further comprises an accepting unit determining whether or not an award entry keyword that has been input in the entry keyword input field is the same as a search keyword that has appeared on a web page containing a search keyword input field an accepting an award entry when they are the same when the award entry is transmitted from the user's terminal apparatus through the network (See column 5, lines 47-67, and column 6, lines 1-20, wherein "accepting unit determining" reads on "satisfies certain pre-determine a criteria", and wherein "user's terminal apparatus" reads on "client...customer's computer", also see column 12, lines 40-67, wherein "is the same as" reads on "provides status information for the consumer regarding participation in the host incentive programs").

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified De La Huerga et al. to include is award entry information; wherein the information server further comprises an accepting unit determining whether or not an award entry keyword that has been input in the entry keyword input field is the same as a search keyword that has appeared on a web page containing a search keyword input field an accepting an award entry when they are the same when the award entry is transmitted from the user's terminal apparatus through the network.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified De La Huerga et al. by the teaching of Eggleston et al. to include is award entry information; wherein the information server further comprises an accepting unit determining whether or not an award entry keyword that has been input in the entry keyword input field is the same as a search keyword that has appeared on a web page containing a search keyword input field an accepting an award entry when they are the same when the award entry is

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transmitted from the user's terminal apparatus through the network because a database can store any user customizable information/records fitting to the user's preference regardless of its type.

As to claim 10, De La Huerga et al. as modified discloses wherein said keyword input page transmitting unit changes the entry keyword whenever said keyword input page transmitting unit transmits a web page containing the search keyword input field (See Eggleston et al. column 10, lines 28-54, wherein "transmitting unit" reads on "connected by a telecommunications connection", and wherein "web page containing the search keyword input field" reads on "web browser").

As to claim 12, De La Huerga et al. discloses wherein the content information whose location is unpublished (See De La Huerga et al. column 9, lines 55-67, and column 10, lines 1-20),

wherein an entry keyword appears on the web page (See De La Huerga et al. column 10, lines 20-67), and wherein the user's terminal apparatus further comprises:

an entry keyword transmitting unit transmitting the keyword that has been input in the entry keyword input field to the network (See De La Huerga et al. column 2, lines 37-67).

De La Huerga et al. does not teach is award entry information.

Eggleston et al. teaches is award entry information (See Eggleston et al. column 33, lines 56-65, also see column 35, lines 60-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified De La Huerga et al. to include is award entry information.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified De La Huerga et al. by the teaching of Eggleston et al. to include is award entry information because a database can store any user customizable information/records fitting to the user's preference regardless of its type.

As to claim 19, De La Huerga et al. discloses an information searching apparatus for searching for location information that represents location on a network where information containing a keyword transmitted from a user's terminal apparatus, based on the keyword (See De La Huerga et al. column 6, lines 33-67, also see De La Huerga et al. column 2, lines 17-51, prior art), comprising:

a regular search service index database storing a keyword contained in content information that is published on the network, in connection with location information representing location on the network where the published content information exists (See De La Huerga et al. column 12, lines 17-67, also see De La Huerga et al. column 2, lines 17-51, prior art, wherein "indexing" is inherently preformed by "search engines");

the location on the network of which is unpublished, in connection with location information representing the location on the network where the unpublished content information exists (See De La Huerga et al. column 9, lines 18-67, and see De La Huerga et al. column 10, lines 1-67); and

based on a keyword transmitted from the user's terminal apparatus browsing a specific web page, and searching for the location information referring to the regular service index

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database when searching for location information, based on other keywords (See De La Huerga et al. column 9, lines 18-67, and see De La Huerga et al. column 10, lines 1-67).

De La Huerga et al. does not teach a promotion index database storing a keyword contained in content information; and

a searching unit searching for the location information referring to the regular search service index database and promotion index database when searching for location information.

Eggleston et al. teaches a promotion index database storing a keyword contained in content information (See Eggleston et al. column 20, lines 1-32);

a searching unit searching for the location information referring to the regular search service index database and promotion index database when searching for location information (See Eggleston et al. column 12, lines 12-57).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified De La Huerga et al. to include a promotion index database storing a keyword contained in content information; a searching unit searching for the location information referring to the regular search service index database and promotion index database when searching for location information.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified De La Huerga et al. by the teaching of Eggleston et al. to include a promotion index database storing a keyword contained in content information; a searching unit searching for the location information referring to the regular search service index database and promotion index database when searching for location information because catering a database to

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specific type of record provides for efficient database based on user preference and thereby reducing business costs.

As to claim 20, De La Huerga et al. as modified wherein said specific web page is a form for award entry, and

said searching unit making the search based on a keyword input to an award entry keyword input field provided on the specific web page (See Eggleston et al. column 33, lines 56-65, also see Eggleston et al. column 35, lines 60-67, also see Eggleston et al. column ).

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Miyasaka et al. (U.S. Patent No. 6,070,162) teaches information search and collection system.

Bowen et al. (U.S. Patent No. 6,094,649) teaches keyword searched of structured databases.

Matsushima et al. (U.S. Pub. No. 2002/0138439 A1) teaches content distribution system and reference server.

Wray et al. (U.S. Pub. No. 2003/0005287 A1) teaches method of extensible positive client ID.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 703-305-8114. The examiner can normally be reached on 8:00AM-4: 30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on 703-305-3830. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Neveen Abel-Jalil  
October 19, 2003

  
**CHARLES RONES**  
**PRIMARY EXAMINER**